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PATENT

100.2471
Ross 6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ross
Serial No.: 09/735,335
Filed: December 11, 2000
For: TELECOMMUNICATIONS SYSTEM FOR BROADCASTING AND
RECEIVING INFORMATION WHOSE PERTINENCE IS AT LEAST
PARTIALLY BASED ON GEOGRAPHY
Group: 3629
Examiner: Jonathan Ouellette

Durham, North Carolina
April 6, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATION OF FACSIMILE TRANSMISSION

Sirs:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax. No. 571-273-8300 on the date set forth below

1. Transmittal of Appellant's Brief (1 page).
2. PTO-2038 Credit Card Payment Form (1 page).
3. Appeal Brief (29 pages).

Peter H. Priest
Printed name of person signing

Peter H. Priest
Signature

Date: April 6, 2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of : Ross
For : Telecommunications System for
Broadcasting and Receiving Information
whose Pertinence is at Least Partially Based
on Geography
Serial No. : 09/735,335
Filed : 12/11/2000
Group : 3629
Examiner : Jonathan Ouellette

Durham, North Carolina
April 6, 2007

MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

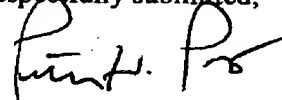
TRANSMITTAL OF APPELLANT'S BRIEF

Dear Sirs:

1. Transmitted herewith is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on February 6, 2007.
 2. The Applicant is other than a small entity.
 3. Pursuant to 37 CFR 1.17(f) the fee for filing the Appeal Brief is \$500.00.
- [x] The Commissioner is hereby authorized to charge the fee of \$500 to our credit card. A credit card form is attached.

- ☐ The Commissioner is hereby authorized to charge the 1 month extension fee of \$120 to our credit card. This letter petitions for a one month extension of time.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Law Offices of Peter H. Priest Deposit Account No. 50-1058.

Respectfully submitted,



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APPELLANT'S BRIEF

Sir:

1. The Real Party In Interest

The real party in interest is the assignee, Lucent Technologies Inc.

2. Related Appeals and Interferences

None.

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3. Status of the Claims

This is an appeal from the November 13, 2006, final rejection of claims 1-28, all of the pending claims. Claims 1-4, 6-9, 11, 12, 14, 15, 17-21, and 23-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Ernst et al. U.S. Patent No. 5,636,245 ("Ernst"). Claims 5, 10, 13, 16, 22, and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ernst. Pending claims 1-28 are the subject of this appeal.

4. Status of Amendments

The claims stand as last amended on May 13, 2005.

5. Summary of Claimed Subject Matter

In our society most people are overwhelmed by the deluge of information that is delivered to them. Every day, newspapers, magazines, television, radio, and the Internet each provide more information than any person could ever assimilate. The problem is exacerbated by the fact that each of these media, albeit to different degrees, deliver information to people for whom that information is unlikely to be of interest, and, therefore, each person must spend a considerable amount of time and effort just culling information of interest from information that is not of interest.

Claim 1

Turning to an aspect of the present invention, claim 1 addresses a telecommunications terminal, e.g., terminal 102-I, which includes a receiver 301 and a processor 303. See e.g., specification, p. 5, lines 5-16 and Fig. 3. The receiver receives broadcasted geographically-sensitive messages having associated geographic locations of relevance and priorities. See, e.g., specification, p. 6, lines 10-25, p. 9, lines 3-23, and Figs. 9 and 11. The receiver ascertains a geographic location of the telecommunications terminal. See, e.g., specification, p. 11, lines 8-

12. Based on the geographic location of the telecommunications terminal, the processor determines a geographic region of interest for the telecommunications terminal. See, e.g., specification, p. 11, lines 13-25. The processor also determines whether the geographic locations of relevance associated with the broadcasted geographically-sensitive messages are within the geographic region of interest for the telecommunications terminal. See, e.g., specification, p. 12, lines 25-28 and Fig. 15. The processor also filters out the broadcasted geographically-sensitive messages whose associated geographic locations of relevance are not within the determined geographic region of interest of the telecommunications terminal. Moreover, the processor orders the unfiltered messages according to their associated priorities. See, e.g., specification, p. 9, lines 17-23. See also, e.g., claim 6.

By way of example, referring to p. 9, lines 20-23 of the present specification, a geographically-sensitive message concerning a sale at a store in a geographic region of relevance 613 could be assigned a lower priority than a geographically-sensitive message concerning a tornado in the same geographic region of relevance 613 so that the more urgent message is delivered first. A customer could readily create a profile so that he or she would get messages in a desired order. Similarly, an advertiser using the system could pay a higher fee for a higher priority. Other examples of the advantageousness of the flexibility provided by the present approach are many.

Claim 11

A telecommunications terminal 102-i according to an aspect of the present invention as claimed in claim 11 includes a receiver 301, a means for ascertaining a geographic location 102-i of the telecommunications terminal, and a processor 303. The receiver receives a first message having a definition of a geographic region of relevance and an associated indicium of the

geographic region of relevance. Specification, p. 7, line 25 – p. 8, line 2 and Fig. 7. By receiving both a definition of a geographic region of relevance and an associated indicium of the same, the telecommunications terminal may correlate the indicium with the definition for recognition of subsequent messages which carry the indicium. The receiver also receives broadcasted geographically-sensitive messages containing geographically-sensitive information. The broadcasted geographically-sensitive messages are labeled with indicium of a geographic region of relevance without the need for also carrying the definition. Specification, p. 10, lines 13-17 and Fig. 10. By way of example, an indicium, such as "LJD61121", may be associated with a region shaped by a circle with its center at coordinates 613-1 having coordinate 613-2 on the circle in the first message. On subsequent broadcast messages, the LJD61121 indicium will be carried with geographically sensitive information relevant to the geographical area defined by the circle. Specification, p. 8, lines 10-14.

The means for ascertaining a geographic location of the telecommunications terminal ascertains the geographic location of the telecommunications terminal. For example, the telecommunications terminal may include a global positioning system receiver to obtain its location. Specification, p. 11, lines 8-12.

The processor determines geographic regions of relevance from the associated indicia supplied in the broadcasted geographically-sensitive messages and determines whether the geographic location of said telecommunications terminal is within the determined geographic region of relevance. Specification, p. 12, line 29 – p. 13, line 2. The processor filters out the broadcasted geographically-sensitive messages when said geographic location of said telecommunications terminal is not within the determined geographic region of relevance

indicated by an associated indicium supplied in a broadcasted geographically-sensitive message.

Specification, p. 13, lines 1-2 and Fig. 13. See also claim 14.

Claims 17 and 23

A telecommunications terminal 102-i according to an aspect of the present invention as claimed in claims 17 and 23 includes a receiver 301 and a processor 303. Specification, p. 5, lines 5-16 and Fig. 3. The features of claims 17 and 23 are similar to those features in claims 11 and 14. However, the processor of claims 17 and 23 determines a geographic region of interest based on the geographic location of the telecommunications terminal. With the geographic region of interest determined, the processor then determines whether the determined geographic regions of relevance of the broadcasted messages overlap the determined geographic region of interest. If there is no overlap, the broadcasted messages are filtered out. Specification, p. 13, lines 3-6 and Figs. 13 and 17.

6. Grounds of Rejection to be Reviewed on Appeal

Claims 1-4, 6-9, 11-12, 14-15, 17-21, and 23-27 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ernst. Claims 5, 10, 13, 16, 22, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ernst.

7. Argument

A. Rejection under 35 U.S.C. § 102(b) over Ernst

The rejection under 35 U.S.C. § 102(b) does not follow MPEP § 706.02(IV) which states at page 700-21 "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." In contrast with this clear requirement, the final Office Action bases an anticipation rejection on portions of Ernst, which do not teach each feature of the claimed combination of elements and thus cannot anticipate the presently claimed

invention. For the above reason, this rejection should be reversed.

At col. 1, lines 61-65, Ernst addresses a system which is capable of determining whether information broadcast by a general transmitter is relevant to a particular user based on the location, velocity and/or position of an object of interest. Ernst's system includes a general transmitter responsive to the detection of an event. Ernst, col. 3, lines 1-2. The general transmitter, in turn, broadcasts "messages including a segment comprising a region, a velocity and/or a time." Ernst, col. 2, lines 2-4. The segment may include an event specific tag which indicates the type of event detected. Ernst, col. 3, lines 26-28. Although Ernst does not disclose specific event types, it appears from the overall disclosure of Ernst that these events would indicate an impending tactical ballistic missile attack, positions of local friend or foe unit, a Nuclear/Biological/Chemical (NBC) occurrence or the like. Ernst, col. 2, lines 46-63.

Ernst's system also includes a remote unit which receives the broadcasted messages and also receives selection criteria from a selection criteria unit 125. Ernst, Fig. 1. The remote unit uses the selection criteria to determine whether the stored position, velocity and/or time information are within matching conditions of the position, velocity and/or time information for the segment of the transmitted message." Ernst, col. 3, lines 53-58. Ernst does not disclose the particular selection criteria for determining whether a broadcast message should be filtered out as claimed. Furthermore, Ernst does not disclose and does not make obvious a broadcasted message having a priority and ordering the unfiltered messages according to that priority as claimed.

Claims 1 and 6

Claim 1 recites "a processor configured ... to filter out the broadcasted geographically-sensitive messages whose associated geographic locations of relevance are not within said

geographic region of interest of said telecommunications terminal, and to order the unfiltered messages according to their associated priorities.”

To order the unfiltered messages according to their associated priorities, claim 1 requires “receiving a plurality of broadcasted geographically-sensitive messages having associated geographic locations of relevance and priorities.” The cited portions of the Ernst disclosure fail to address prioritization of broadcasted messages at all. See Ernst, col. 3, lines 10-30, col. 3, lines 46-67, col. 1, lines 1-4. Ernst does not disclose and does not make obvious “receiving a plurality of broadcasted geographically-sensitive messages having associated geographic locations of relevance and priorities,” as claimed in claim 1. (emphasis added) With regard to messages generated from Ernst’s general broadcaster, Ernst’s message merely discloses a segment which may include an event specific tag indicating the type of event detected by the general transmitter. Such a tag is not inherently a priority as recited in claim 1.

The Official Action contends that Ernst discloses priorities carried in the broadcasted messages and cites col. 3, lines 65-67 and col. 1, lines 1-4 as supporting the proposition that predesignated event specific tags are entered at a criteria selection unit. It is believed that the reference to Ernst col. 1, lines 1-4 is intended to be a reference to col. 4, lines 1-4. The Official Action contends that the inclusion or exclusion of a message on a list represents determining a priority.

The Applicant respectfully disagrees with the proposition that the choice of excluding or including a message represents an assignment of a priority to that message. Ernst simply includes or excludes messages based on whether they meet specified criteria, such as including appropriate event specific tags. This inclusion or exclusion does not take into account the status of other messages, and does not take into account the possibility of greater or lesser degrees of

importance of a message, so long as the message includes appropriate tags. Assigning of a priority to a message, by contrast, assigns a degree of greater or lesser importance to the messages, and the actions to be taken with respect to a message with a particular priority may depend on the presence or absence of other messages which may be present and may need to be evaluated to determine whether and in what order they are to be presented. Assignment of a priority to a message and consideration of that priority in handling the message allows for more flexibility in treatment of the message than does simple inclusion or exclusion depending on whether the message meets specified criteria. For example, a message may be delivered only if higher priority messages are not being transmitted, or may be delivered only after higher priority messages have been delivered.

Ernst does not explicitly disclose or discuss prioritizing messages, and prioritizing of messages is not inherent in Ernst's inclusion or exclusion of messages based on whether an event appears on a user's event specific tag list. According to MPEP Section 2112, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " The MPEP continues by further stating "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not met this burden here. An event specific tag is not inherently a priority as recited in claim 1.

In addition, Ernst says nothing about ordering messages. During previous prosecution of the present Application, the Examiner contended that ordering of a message according to a priority was grounds for rejection under 35 U.S.C. § 101 and 35 U.S.C. § 112. However, in the November 13, 2006 Official Action which is the subject of the present Appeal, these grounds of rejection are stated to be withdrawn. In the Response to Arguments section, however, the Examiner argues that the prioritization element is not repeatable or concrete, because of the "subjective nature of establishing the priority of the broadcasted message". In a previous Official Action dated March 21, 2006, the Examiner argued that the prioritization feature was not concrete because a user might set priorities in any number of different ways according to the user's assessment of the priority of the message.

In the first instance, the Applicant contends that this position has been withdrawn and believe that raising it in the Response to Arguments was in error. In the second instance, the fact that different users might employ an invention in different ways does not detract from the utility of the invention. Different users of the present invention might employ different sets of priority criteria because of their differing needs, and the differing nature of the sets of messages they wished to manage. The prospect that different users might implement the invention in different ways in order to accommodate their differing needs does not indicate a need for undue experimentation in order to carry out the invention. Instead, the present invention provides users with the ability to set priorities so as to meet their needs, whatever their needs may happen to be. Therefore, any rejection under 35 U.S.C. § 101 and 35 U.S.C. § 112, or any failure to consider elements of the claims based on lack of utility of those elements, is improper.

Claim 6 claims, inter alia, filtering out the geographically-sensitive messages whose associated geographic locations of relevance are not within said geographic region of interest of

said telecommunications terminal, and ordering the unfiltered geographically-sensitive messages according to their associated priorities. For the reasons given above with respect to claim 1, claim 6 defines over Ernst.

Claims 2-4 and 7-9

Since claims 2-4 and 7-9 are dependent on claims 1 and 6, respectively, claims 4 and 9 define over Ernst in the same manner as claim 1. Additionally, claims 4 and 9 base the geographic region of interest of a telecommunications terminal on the associated priority of the received broadcasted geographically-sensitive message. Since the cited portions of Ernst do not disclose carrying a priority indicator in the broadcast message as claimed, Ernst does not disclose and has no reason to disclose basing the geographic region of interest of a telecommunication terminal "on the associated priority of said geographically-sensitive message," as claimed in claim 4. Instead Ernst discloses that the "stored position, velocity and/or time information are within matching conditions of the position, velocity and/or time information for the segment of the transmitted message." Ernst, col. 3, lines 53-58. But such disclosure does not necessarily imply basing the geographic region of interest of a telecommunication terminal "on the associated priority of said geographically-sensitive message," as claimed in claim 4.

Claims 11 and 14

Claims 11 and 14 address another technique for filtering geographically-sensitive messages at a telecommunications terminal having a receiver and a processor. In particular, the receiver receives a first message that associates a definition of a geographic region of relevance with an indicium of the geographic region of relevance. The receiver also receives broadcasted geographically-sensitive messages which are labeled with an indicium of a geographic region of relevance. By broadcasting an indicium of a geographic region of relevance rather than the

definition of the geographic region of relevance in each broadcasted message, the message size is advantageously reduced. Claim 11 recites “a receiver for receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance and for receiving a plurality of broadcasted geographically-sensitive messages, the plurality of broadcasted geographically-sensitive messages being labeled by the indicium of a geographic region of relevance; a processor configured to determine geographic regions of relevance from the associated indicia supplied in the plurality of broadcasted geographically-sensitive messages and to determine whether said geographic location of said telecommunications terminal is within the determined geographic region of relevance.”

Ernst does not disclose and does not make obvious “receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance and for receiving a plurality of broadcasted geographically-sensitive messages,” as claimed in claim 11. Ernst does not disclose and does not make obvious “the plurality of broadcasted geographically-sensitive messages being labeled by the indicium of a geographic region of relevance,” as claimed in claim 11. Ernst is required to transmit the position, velocity and/or time information on each transmitted message. Ernst, col. 3, lines 20-23. Although Ernst discloses reducing the information in the transmitted message by sending event specific tags, receiving both a first message containing a geographic region definition and associated indicium and broadcast messages with the associated indicium as claimed is not met by the Ernst disclosure of a particular event type. In addition, the position information broadcast by Ernst is not a definition of a region as the term is used in connection with the present invention. A geographic region of interest is defined in the present specification at p. 11, lines 13-16, as a geographic area about which a communications terminal desires to stay informed. A

position is properly thought of as a point, not a region, and a terminal receiving the position information of Ernst must do additional computation to determine if the identified position is within a region of interest, compared to the invention of claim 11, in which an indicium associated with a message can be examined to determine if the indicium indicates a region of interest. Claim 14 similarly addresses determining a geographic region of relevance from an associated indicium supplied in a broadcasted geographically-sensitive message, and determining whether a geographic location of said telecommunications terminal is within the determined geographic region of relevance. Claims 11 and 14 therefore define over Ernst.

Claims 12, 15, and 16

Claim 12 depends on claim 11, including all the limitations of claim 11 and adding additional limitations thereto and claims 15 and 16 depend on claim 14, including all of the limitations of claim 14 and adding additional limitations thereto. Claims 12, 15, and 16 should therefore be allowed on the same basis as claims 11 and 14.

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Claims 17 and 23

Claims 17 and 23 address another technique for filtering geographically-sensitive messages at a telecommunications terminal having a receiver and a processor. In addition to utilizing the first message carrying a definition of a geographic region of relevance and an associated indicium of the geographic region as addressed in detail above, claims 17 and 23 determine a geographic region of relevance based on said geographic location of the telecommunications terminal. The geographic region of relevance of the broadcast message is compared with the determined geographic region of interest. Broadcast messages are filtered out, if the determined regions fail to overlap.

Claim 17 recites the processor operates "to determine a geographic region of interest based on said geographic location of said telecommunications terminal, to determine whether said determined geographic regions of relevance overlap said geographic region of interest, and to filter out said broadcasted geographically-sensitive messages whose determined geographic regions of relevance fail to overlap said geographic region of interest." Ernst does not disclose and does not make obvious determining "a geographic region of interest based on said geographic location of said telecommunications terminal," as claimed in claim 17. Ernst does not disclose and does not make obvious a terminal which operates to "filter out said broadcasted geographically-sensitive messages whose determined geographic regions of relevance fail to overlap said geographic region of interest," as claimed in claim 17.

The portion of Ernst relied upon by the Official Action merely discloses disseminating a message if the stored position, velocity and/or time information are within matching conditions with the position, velocity and/or time information for the message. Ernst, col. 3, lines 46-65. Ernst is silent with respect to particular matching conditions. As defined in the specification at

page 11, lines 14-15 of the present specification, a “geographic region of interest” is a geographic area about which a telecommunications terminal desires to stay informed. (emphasis added) The Ernst disclosure is silent with respect to determining an area and, thus, Ernst is also silent about determining a geographic region of interest. Furthermore, the term “geographic region of relevance” is also defined as an area in which a geographically-sensitive message is relevant. Specification, p. 6, lines 9-10. Since Ernst is silent about determining areas, Ernst is also silent with respect to filtering out broadcasted geographically-sensitive messages whose determined geographic regions of relevance fail to overlap said geographic region of interest as claimed in claim 17. Claim 23 similarly addresses determining a geographic region of interest of a telecommunications terminal based on the geographic location of the telecommunications terminal, determining whether determined geographic regions of relevance overlap the geographic region of interest of the telecommunications terminal, and filtering out the broadcasted geographically-sensitive messages whose associated determined geographic regions of relevance fail to overlap the geographic region of interest of the telecommunications terminal. Claims 17 and 23 therefore define over Ernst.

Claims 18-21 and 24-27

Claims 18-21 depend on claim 17, including all of the limitations of claim 17 and adding additional limitations thereto. Claims 24-27 depend on claim 23, including all of the limitations of claim 23 and adding additional limitations thereto. Claims 18-21 and 24-27 therefore define over Ernst.

B. Rejection under 35 U.S.C. § 103(a) over Ernst

The final rejection under 35 U.S.C. § 103 did not follow M.P.E.P. § 706.02(j) which states:

After indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth...the difference or differences in the claim over the applied reference,...the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and ... an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

As will be illustrated below, the claims of the present invention are not obvious in view of the references relied upon by the Examiner.

The art rejections are not supported by the relied upon art. 35 U.S.C. § 103 which governs obviousness indicates that "differences between the subject matter sought to be patented and the prior art" are to be assessed based upon "the subject matter as a whole". Analyzing the entirety of each claim, the rejections under 35 U.S.C. § 103 are not supported by the relied upon art as addressed further below. Only after an analysis of the individual references has been made can it then be considered whether it is fair to combine teachings. As required by 35 U.S.C. § 103, claims must be considered as a whole. When so considered, the present claims are not obvious.

Turning to dependent claims 10, 13, 16, 22, and 28, these claims address a processor which determines a geographic region of interest wherein the geographic region of interest comprises at least one of a polygon and a conic section.

The Examiner does not follow the established legal standard set forth above. Rather, after correctly admitting that Ernst does not show a geographic region of interest wherein the geographic region of interest comprises at least one of a polygon and a conic section as claimed

in claims 5, 10, 13, 16, 22, and 28, the Examiner rejects these claims on the basis that the differences found in these claims over their associated independent claims are nonfunctional descriptive material and are not functionally involved in the steps recited. The Examiner relies on In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) for the purported rule that “descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.” The Examiner’s analysis of In re Gulack is not supported by this case. In re Gulack addressed the legal issue of when printed matter lends patentable weight, and reversed a finding of obviousness as a matter of law. In reaching this result, the Court emphasized that claims must be considered “as a whole.” The Court found that there was a functional relationship between the printed matter and the substrate in Gulack.

More particularly, In re Gulack involved an invention containing three key elements: (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed. In determining whether the imprinted digits had a functional relationship to the invention, the Court of Appeals for the Federal Circuit at page 404 reasoned that “What is required [to establish a functional relationship] is the existence of differences between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness.” The functional relationship of the claimed geographic regions in the present claims is much clearer than that found dispositive in Gulack.

In re Lowry involved an improper attempt to analogize the printed matter doctrine to the data processing field which was rejected by the Court of Appeals for the Federal Circuit. More

particularly, Lowry's invention included a data structure accessible by many different application programs. The Court noted that Gulack cautioned against a liberal use of "printed matter rejections" under Section 103. The Court criticized the Board of Patent Appeals for erroneously extending a printed matter rejection under sections 102 and 103 to the data processing field despite this cautioning. Rather than supporting the Examiner's rejection, Gulack and Lowry compel the allowance of the claims rejected as obvious.

The Examiner provides no factual support for his reliance upon In re Gulack. The Examiner merely states that "the telecommunications terminal operating system would be performed regardless of the shape of geographic region of interest used." This statement is both technically incorrect and does not address the differences between claims 5, 10, 13, 16, 22 and 28 and Ernst. As addressed above, Ernst does not determine a particular area or region of interest to determine whether the region of relevance of the broadcast message overlaps with the region of interest in the manner claimed. Ernst simply determines whether the stored position, velocity and/or time information are within the position, velocity and/or time information in the message. As noted above, Ernst defines a position, which is properly thought of as a point. Definition of a region including at least one of a polygon and a conic section provides considerable convenience in identifying an event of interest, because an event can be defined as within a geographical area of interest based on the fact that it occurs within the boundaries of a defined region, and defining a region in the manner claimed provides for a specific way of setting boundaries. Ernst, by contrast, does not define regions, but only identifies geographical points of interest, and the information identifying a particular point of interest must then be analyzed to determine if it is of interest to a terminal at a particular location. Claims 5, 10, 13,

16, 22 and 28 address a particular way of determining the region of interest which is not taught and not obvious from Ernst.

To sum up, Ernst does not show and does not suggest a processor for determining a geographic region of interest in the shape of at least one of a polygon and a conic section. Nothing in Ernst indicates a recognition of determining a geographic region of interest in a particular shape as addressed by the present invention. The claims of the present invention are not taught, are not inherent, and are not obvious in light of the art relied upon.

C. The Examiner's Findings of Obviousness Are Also Contrary to Law of the Federal Circuit

As shown above, the invention claimed is not suggested by the relied upon prior art. The references cited by the Examiner, if anything, teach away from the present invention. It is only in hindsight, after seeing the claimed invention, that the Examiner could combine the references as the Examiner has done. This approach is improper under the law of the Federal Circuit, which has stated that "[w]hen prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988), cert. den., 109 S. Ct. 75, 102 L.Ed. 2d 51 (1988); quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1132, 227 U.S.P.Q. 543, 535 (Fed. Cir. 1985). Furthermore, "[i]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal, 837 F.2d at 1051, 5 U.S.P.Q. 2d at 1438. Similarly, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q. 2d 1397,

1398 (Fed. Cir. 1989), quoting In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). No such suggestion is found here.

In addition, the Examiner does not appear to have considered “where the references diverge and teach away from the claimed invention”, Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1481, 1 U.S.P.Q. 2d 1241, 1246 (Fed. Cir. 1986), cert. den., 107 S. Ct. 2490, 482 U.S. 909, 107 S.Ct. 2490 (1987); and W.L. Gore Associates, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); nor has the Examiner read the claims as a whole, as required by statute. 35 U.S.C. §103. See also, Smithkline Diagnostics Inc. v. Helena Laboratories Corp., 859 F.2d 878, 885, 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); and Interconnect Planning Corp., 774 F.2d at 1143, 227 U.S.P.Q. at 551.

In In re Laskowski, 871 F.2d 115, 10 U.S.P.Q. 2d 1397, the Federal Circuit reversed an obviousness rejection of the claims in an application for a bandsaw. The claimed bandsaw used a pulley type wheel loosely fitted with a tire. The primary reference showed a similar bandsaw where the band was tightly fitted. The Federal Circuit stated that the prior art did not provide a suggestion, reason or motivation to make the modification of the reference proposed by the Commissioner. Id. at 1398. The Court added that “there must be some logical reason apparent from the positive, concrete evidence of record which justifies a combination of primary and secondary references.” Id. quoting In re Regel, 526 F.2d 1399, 1403, 188 U.S.P.Q. 136, 139 (C.C.P.A. 1975), citing In re Stemmiski, 444 F.2d 581, 170 U.S.P.Q. 343 (C.C.P.A. 1971).

In Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q. 2d 1434 (Fed. Cir. 1988), cert. den., 109 S. Ct. 75, 102 L.Ed. 2d 51 (1988), the Federal Circuit reversed the District Court’s finding that the claims for a patent for an air flow deflecting shield were obvious.

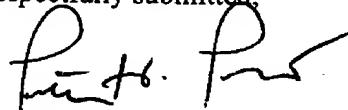
Without any suggestion in the art, the District Court improperly chose features from several prior art references to recreate the claimed invention.

The Examiner's rejection suggests that the Examiner did not consider and appreciate the claims as a whole. The claims disclose a unique combination with many features and advantages not shown in the art. It appears that the Examiner has oversimplified the claims and then searched the prior art for the constituent parts. Even with the claims as a guide, however, the Examiner did not recreate the claimed invention.

8. Conclusion

The rejection of claims 1-28 should be reversed and the application promptly allowed.

Respectfully submitted,



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CLAIMS APPENDIX
(Claims Under Appeal)

1. A telecommunications terminal comprising:
a receiver for receiving a plurality of broadcasted geographically-sensitive messages having associated geographic locations of relevance and priorities, and for ascertaining a geographic location of said telecommunications terminal; and
a processor configured to determine a geographic region of interest of said telecommunications terminal based on said geographic location of said telecommunications terminal, to determine whether the geographic locations of relevance associated with the plurality of broadcasted geographically-sensitive messages are within said geographic region of interest of said telecommunications terminal, to filter out the broadcasted geographically-sensitive messages whose associated geographic locations of relevance are not within said geographic region of interest of said telecommunications terminal, and to order the unfiltered messages according to their associated priorities.
2. The telecommunications terminal of claim 1:
wherein said telecommunications terminal is mobile; and
wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal.
3. The telecommunications terminal of claim 1:
wherein said telecommunications terminal is mobile; and
wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a speed of said telecommunications terminal.
4. The telecommunications terminal of claim 1 wherein said geographic region of

interest is based on the associated priority of said geographically-sensitive message.

5. The telecommunications terminal of claim 1 wherein said geographic region of interest comprises at least one of a polygon and a conic section.

6. A method of operating a telecommunications terminal, said method comprising:
receiving a plurality of geographically-sensitive messages broadcasted to a plurality of telecommunication terminals, and the plurality of geographically-sensitive messages having associated geographic locations of relevance and priorities;

ascertaining a geographic location of said telecommunications terminal;

determining a geographic region of interest of said telecommunications terminal based on said geographic location of said telecommunications terminal;

determining whether the geographic locations of relevance are within said geographic region of interest of said telecommunications terminal;

filtering out the geographically-sensitive messages whose associated geographic locations of relevance are not within said geographic region of interest of said telecommunications terminal; and

ordering the unfiltered geographically-sensitive messages according to their associated priorities.

7. The method of claim 6:

wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal.

8. (previously presented): The method of claim 6 wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a speed of said telecommunications terminal.

9. The method of claim 6 wherein said geographic region of interest is based on the associated priority of said geographically-sensitive message.

10. The method of claim 6 wherein said geographic region of interest comprises at least one of a polygon and a conic section.

11. A telecommunications terminal for filtering geographically-sensitive messages which are broadcasted to a plurality of telecommunication terminals, the telecommunication terminal comprising:

a receiver for receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance and for receiving a plurality of broadcasted geographically-sensitive messages, the plurality of broadcasted geographically-sensitive messages being labeled by the indicium of a geographic region of relevance;

means for ascertaining a geographic location of said telecommunications terminal; and

a processor configured to determine geographic regions of relevance from the associated indicia supplied in the plurality of broadcasted geographically-sensitive messages and to determine whether said geographic location of said telecommunications terminal is within the determined geographic region of relevance, and to filter out the broadcasted geographically-sensitive messages when said geographic location of said telecommunications terminal is not within a determined geographic region of relevance indicated by an associated indicium supplied in a broadcasted geographically-sensitive message.

12. The telecommunications terminal of claim 11 wherein said receiver is also for

receiving a definition of said geographic region of relevance and an indicium, and further comprising a memory for storing said definition of said geographic region of relevance with an indicium of said geographic region of relevance as an index into said memory.

13. The telecommunications terminal of claim 11 wherein said geographic region of relevance comprises at least one of a polygon and a conic section.

14. A method of operating a telecommunications terminal to filter geographically-sensitive messages which are broadcasted to a plurality of telecommunications terminals, said method comprising:

receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region;

receiving a plurality of broadcasted geographically-sensitive messages having associated indicia of a geographic region of relevance;

ascertaining a geographic location of said telecommunications terminal;

determining a geographic region of relevance from the associated indicium supplied in a broadcasted geographically-sensitive message; and

determining whether said geographic location of said telecommunications terminal is within the determined geographic region of relevance; and

disregarding the broadcasted geographically-sensitive messages when said geographic location of said telecommunications terminal is not within the determined geographic region of relevance.

15. The method of claim 14 further comprising:

receiving a definition of each geographic region of relevance and an indicium of said geographic region of relevance before receiving said geographically-sensitive message; and

storing said definition of said geographic region of relevance into a memory with said indicium of said geographic region of relevance as an index into said memory.

16. The method of claim 14 wherein said geographic region of relevance comprises at least one of a polygon and a conic section.

17. A telecommunications terminal comprising:

a receiver for receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance and for receiving a plurality of broadcasted geographically-sensitive messages, the plurality of broadcasted geographically-sensitive messages having associated indicia of geographic regions of relevance and for ascertaining a geographic location of said telecommunications terminal; and

a processor configured to determine geographic regions of relevance from the associated indicia supplied in the plurality of broadcasted geographically-sensitive messages, to determine a geographic region of interest based on said geographic location of said telecommunications terminal, to determine whether said determined geographic regions of relevance overlap said geographic region of interest, and to filter out said broadcasted geographically-sensitive messages whose determined geographic regions of relevance fail to overlap said geographic region of interest.

18. The telecommunications terminal of claim 17:

wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal.

19. The telecommunications terminal of claim 17 wherein said receiver is also for receiving a definition of said geographic region of relevance, and further comprising a memory

for storing said definition of said geographic region of relevance and an indicium of said geographic region of relevance as an index into said memory.

20. The telecommunications terminal of claim 17:

wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a speed of said telecommunications terminal.

21. The telecommunications terminal of claim 17 wherein said geographic region of interest is based on a priority of said geographically-sensitive message.

22. The telecommunications terminal of claim 17 wherein said geographic region of interest comprises at least one of a polygon and a conic section.

23. A method of operating a telecommunications terminal, said method comprising:

receiving a first message having a definition of a geographic region of relevance and an associated indicium of the geographic region of relevance;

receiving a plurality of broadcasted geographically-sensitive messages having associated indicia of geographic regions of relevance;

ascertaining a geographic location of said telecommunications terminal;

determining geographic regions of relevance from the associated indicia supplied in the plurality of broadcasted geographically-sensitive messages;

determining a geographic region of interest of said telecommunications terminal based on said geographic location of said telecommunications terminal;

determining whether the determined geographic regions of relevance overlap said geographic region of interest of said telecommunications terminal; and

filtering out the broadcasted geographically-sensitive messages whose associated

determined geographic regions of relevance fail to overlap said geographic region of interest of said telecommunications terminal.

24. The method of claim 23:

wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a direction of motion of said telecommunications terminal.

25. The method of claim 23 further comprising:

receiving a definition of said geographic region of relevance and an indicium of said geographic region of relevance before receiving said geographically-sensitive message; and

storing said definition of said geographic region of relevance into a memory with said indicium of said geographic region of relevance as an index into said memory.

26. The method of claim 23:

wherein said telecommunications terminal is mobile; and

wherein said geographic region of interest is based on said geographic location of said telecommunications terminal and on a speed of said telecommunications terminal.

27. The method of claim 23 wherein said geographic region of interest is based on a priority of said geographically-sensitive message.

28. The method of claim 23 wherein said geographic region of interest comprises at least one of a polygon and a conic section.

EVIDENCE APPENDIX

No items.

RELATED PROCEEDINGS APPENDIX

No items.